



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/966,845

09/28/2001

Barbara J. Boe

065027.0103

4972

5073

7590

01/29/2009

BAKER BOTTS L.L.P.

2001 ROSS AVENUE

SUITE 600

DALLAS, TX 75201-2980

EXAMINER

RETTA, YEHDEGA

ART UNIT

PAPER NUMBER

3622

NOTIFICATION DATE

DELIVERY MODE

01/29/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptomail1@bakerbotts.com

glenda.orrantia@bakerbotts.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARBARA J. BOE, JULIA M. HAMRICK, and
MARJORIE L. AARANT

Appeal 2008-2338
Application 09/966,845¹
Technology Center 3600

Decided: January 26, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Barbara J. Boe, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the Final Rejection of claims 1-28. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

¹ This is an application for reissue of US 6,236,975 B1 [hereinafter “‘975”].

SUMMARY OF DECISION

We AFFIRM-IN-PART.²

THE INVENTION

The invention relates to a method and system for profiling customers for targeted marketing. “In general, the system of the present invention allows a business to survey specific customers and to identify ones of such customers that might want to purchase particular products or services.” ‘975 2:67-3:2. The system involves providing a customer with a survey. “... [S]urvey system 12 [see Fig. 1] may present survey questions to the customer. Once the survey, or a specified portion of it, is completed by the customer, survey system 12 may then transmit graphical feedback reports to customer system 16 [see Fig. 1] to show the customer how his or her responses compare to responses of other customers with the same or similar demographics.” ‘975 3:29-35.

There are 28 claims on appeal, of which method claim 1 and apparatus claims 15 and 23 are the independent claims. Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method of compiling customer data using an online interaction between a customer and a survey system, comprising:
 - providing the customer with customer questions;
 - receiving responses to the customer questions from the customer;

² Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Feb. 26, 2007) and Reply Brief (“Reply Br.,” filed Aug. 20, 2007), and the Examiner’s Answer (“Answer,” mailed Jun. 18, 2007).

storing data associated with the responses in the survey system;
providing the customer with a feedback page, graphically illustrating data corresponding to the customer's standing in a selected peer group associated with the customer;
providing the customer with options operable to adjust the customer's actual demographic to a hypothetical demographic ;
receiving and processing data associated with hypothetical demographic changes from the customer; and
displaying hypothetical feedback information, graphically illustrating the hypothetical standing of the customer within the selected peer group such that the customer can see the effect of the hypothetical demographic changes.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Williams	US 5,999,918	Dec. 7, 1999
Jones, III	US 6,925,441 B1	Aug. 2, 2005
Marsh	US 5,848,397	Dec. 8, 1998

Official Notice: "Official Notice is taken that [sic] is old and well known in the art of collecting data to provide percentage of completed question [sic] ant [sic] the date of the last visit." (Answer 6).

The following rejections are before us for review:

1. Claims 1-9, 11-19, 22, 26, and 27 are rejected under 35 U.S.C. § 102(e) as being anticipated by Williams.

2. Claims 10, 12, 20, and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams and Official Notice.
3. Claims 23-25 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Jones, III and Marsh.
4. Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams and Jones, III.

ISSUES

The first issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 1-9, 11-19, 22, 26, and 27 under 35 U.S.C. § 102(e) as being anticipated by Williams. As to the method claims 1-9, 11-14, and 26, the issue turns on whether the Examiner has shown that Williams describes, expressly or inherently, a “feedback page, graphically illustrating data corresponding to the customer's standing in a selected peer group associated with the customer ... [and] displaying hypothetical feedback information, graphically illustrating the hypothetical standing of the customer within the selected peer group.” As to the system claims 15-19, 22, and 27, the issue turns on whether the Appellants have rebutted the Examiner’s rationale for rejecting these claims.

The second issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 10, 12, 20, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Williams and Official Notice. As to the method claims 10 and 12, the issue turns on whether the Examiner has shown that Williams describes, expressly or inherently, a “feedback page, graphically illustrating data corresponding to the customer's standing in a selected peer group associated with the customer ... [and] displaying

hypothetical feedback information, graphically illustrating the hypothetical standing of the customer within the selected peer group.” As to the system claims 20 and 21, the issue turns on whether the Appellants have rebutted the Examiner’s rationale for rejecting these claims.

The third issue before us is whether the Appellants have shown that the Examiner erred in rejecting claims 23-25 under 35 U.S.C. § 103(a) as being unpatentable over Jones, III and Marsh. This issue turns on whether the Appellants’ arguments that “there is no suggestion or motivation in the Jones III, et al. patent or the Marsh, et al. patent to combine them as proposed by the Examiner” (App. Br. 11), that “a reasonable expectation of success has not been shown by the Examiner” (App. Br. 12), and, that “the Examiner has not shown that the proposed Jones III et al. – Marsh, et al. combination teaches and suggests all of the claim limitations” (App. Br. 13) are persuasive.

The fourth issue before us is whether the Appellants have shown that the Examiner erred in rejecting claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Williams and Jones, III. The issue turns on whether the Appellants have rebutted the Examiner’s rationale for rejecting this claim.

FINDINGS OF FACT

We find that the following enumerated findings of fact (FF) are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

The scope and content of the prior art

1. The Examiner indicated that “Jones teaches ... a survey system operable to supply the business data processing system with a targeted marketing reports, the targeted marketing reports dynamically generated based on a set of decision rules, the set of decision rules (see col. 13 line 19 to col. 14 line 8) dynamically generated based on data received directly from the customer (see fig. 7-11, fig. 14, col. 6 line 38 to col. 17 line 45, col. 9 line 7-58).” (Answer 6).
2. The Examiner indicated that Marsh discloses directly receiving data from consumers. (Answer 7).

Any differences between the claimed subject matter and the prior art

3. The Examiner indicated that “Jones failed to explicitly teach the demographic data being received directly from the consumer, it is taught in Marsh.” (Answer 7). The Examiner appears to take the position that the difference between the claimed subject matter (i.e., claim 23) and Jones, III and Marsh is that the claimed subject matter combines elements and features separately disclosed in the references.

The level of skill in the art

4. Neither the Examiner nor the Appellants have addressed the level of ordinary skill in the pertinent art of compiling survey data. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to

reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163 (Fed. Cir. 1985)).

Secondary considerations

5. There is no evidence on record of secondary considerations of non-obviousness for our consideration.

PRINCIPLES OF LAW

Anticipation

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the

prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S.Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 1-9, 11-19, 22, 26, and 27 under § 102(e) as being anticipated by Williams.

Claim 1

Claim 1 is drawn to a “method of compiling customer data using an online interaction between a customer and a survey system” comprising seven steps.

According to the Examiner, Williams describes the first three steps of the claimed method (“providing the customer with customer questions; receiving responses to the customer questions from the customer; storing data associated with the responses in the survey system”) at Figs. 6a-6e and col. 14, line 62 to col. 15, line 12. (Answer 3). This does not appear to be in dispute.

According to the Examiner, Williams describes the fourth step of the claimed method (“providing the customer with a feedback page, graphically illustrating data corresponding to the customer's standing in a selected peer group associated with the customer”) at Fig. 1h and col. 15, line 45 to col. 16, line. 19. (Answer 3). This is in dispute. According to the Appellants,

“FIGURE 1h merely shows a individual user’s accumulated savings with interest through the years compared to that individual user’s contributions and withdrawals. There is no showing of how the individual stands within any group let alone a selected peer group associated with the individual user.” (App. Br. 7-8).

According to the Examiner, Williams describes the last three steps of the claimed method (“providing the customer with options operable to adjust the customer's actual demographic to a hypothetical demographic; receiving and processing data associated with hypothetical demographic changes from the customer; and displaying hypothetical feedback information, graphically illustrating the hypothetical standing of the customer within the selected peer group such that the customer can see the effect of the hypothetical demographic changes”) at Figs. 1i-11, col. 9, line 5 to col. 10, line 32, and col. 16, lines 14-49. (Answer 3-4). This is in dispute. According to the Appellants, “Williams, et al. patent merely provides a specific output for a particular individual with no comparison to any group let alone a selected peer group as required in the claimed invention. Moreover, the Williams, et al. patent fails to disclose how hypothetical changes affect a hypothetical standing of the customer within that selected peer group as required in the claimed invention.” (App. Br. 8-9).

The Examiner responded to the Appellants’ arguments challenging the Examiner’s contention that Williams describes the last four steps of claim 1 as follows:

Appellant argues that there is no showing in fig.1h and 6b of how the individual stands within any group let alone a selected peer group associated with the individual user. Examiner

would like to point out that Examiner cited fig. 1h and col. 15 line 45 to col. 16 line 19 and also fig. 1i-11, col. 9 line 5 to col. 10 line 32 and col. 16 lines 14- 49. Williams discloses, "a graphic depiction of portfolio returns showing absolute returns, and comparisons to bench-marks is shown". Williams further teaches in a preferred embodiment, the user is able to see how his or her recommended (or actual) portfolio compares to others (see col. 15 line 65 to col. 16 line 4). Fig. 1h shows entering different data to see the outcome. For example if an individual enters data with starting with a zero saving, starts saving at the age of 41, and retires at the age of 66 then the retirement savings is shown to be \$146,211. The graph shows not just the outcome for the individual user but for anyone between ages 41 and 90 (peer group). William also shows the option to adjust the contribution to have different outcome. If the user in William changes the starting age to for example 35 (hypothetical age) or the yearly saving (hypothetical), the graph would include the outcome (different savings) for age 35 to age 90, same as appellant's disclosure (see appellant's fig. 4c).

(Answer 8).

The Appellants replied by repeating the arguments made in the Brief; for example, "Williams, et al. patent merely provides a specific output for a particular individual with no comparison to any group let alone a selected peer group as required in the claimed invention. Moreover, the Williams, et al. patent fails to disclose how hypothetical changes affect a hypothetical standing of the customer within that selected peer group as required in the claimed invention." (Reply Br. 8-9).

Central to the dispute over whether Williams describes the limitations set forth in the last four steps of the claimed method is whether Williams describes a peer group associated with the user. Claim 1 requires a “feedback page, graphically illustrating data corresponding to the customer's standing in a selected peer group associated with the customer ... [and] displaying hypothetical feedback information, graphically illustrating the hypothetical standing of the customer within the selected peer group.” Accordingly, to anticipate the claimed method, Williams must explicitly or inherently describe a selected peer group associated with a customer such that graphical illustrations of the customer’s standing and hypothetical standing in the selected peer group can be provided.

In that regard, we agree with the Examiner that Williams describes a peer group associated with the user. (See col. 16, lines 1-3): “In a preferred embodiment, the user is able to see how his or her recommended (or actual portfolio compares to others.” We do not see that the Appellants have disputed this language cited by the Examiner as evidence that Williams describes a peer group associated with the user.

The question then becomes whether Williams describes “feedback page, graphically illustrating data corresponding to the customer's standing in a selected peer group associated with the customer ... [and] displaying hypothetical feedback information, graphically illustrating the hypothetical standing of the customer within the selected peer group.” In that regard, the Examiner further pointed to Figs. 1h and 6b. We have reviewed these Figures but have not been able to find any express description of a graphical illustration of a customer’s standing or hypothetical standing in a selected peer group. Fig. 1h shows an interactive planner depicting retirement

savings needed depending on values entered for various variables. See discussion in Williams at col. 15, lines 45-63. Fig. 6b shows a user profile whereby a user inputs his or her goals for retirement. (See col. 14, line 66 to col. 15, line 1). We do not see in the disclosures cited by the Examiner any express description of a graphical illustration of a customer's standing or hypothetical standing in a selected peer group, notwithstanding, as we have found earlier, that Williams does describe in elsewhere in the disclosure a peer group associated with the user.

Since there is no express description of the last four steps of the claimed method, to anticipate the claimed method, Williams must inherently describe a graphical illustration of a customer's standing or hypothetical standing in a selected peer group. In that regard, under principles of inherency, when a reference is silent about an asserted inherent characteristic, it must be clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). We do not find that one of ordinary skill would find a graphical illustration of a customer's standing or hypothetical standing in a selected peer group necessarily present in Williams. While it would be possible for one of ordinary skill in the art practicing the Williams method to provide a graphical illustration of the customer's standing or hypothetical standing in a selected peer group, especially given Williams' broad disclosure of a peer group associated with a user, "[i]nherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Hansgirg v. Kemmer*, 102 F.2d 212, 214

(CCPA 1939), quoted in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991).

Because we find that Williams does not expressly or inherently describe the claimed method and all its limitations, we reverse the rejection of claim 1, and claims 2-9, 11-14, and 26 that depend on it, under § 102 over Williams.

Claims 15-19, 22, and 27

Unlike method claims 1-9, 11-14, and 26, these are apparatus claims which do not require a “feedback page, graphically illustrating data corresponding to the customer's standing in a selected peer group associated with the customer ... [and] displaying hypothetical feedback information, graphically illustrating the hypothetical standing of the customer within the selected peer group” but rather a “survey system *operable* to ... provide a feedback page graphically illustrating data corresponding to the customer's standing in a selected peer group associated with the customer ... [and] display hypothetical feedback information graphically illustrating the hypothetical standing of the customer within the selected peer group” (claim 15). Neither the Examiner nor the Appellants have appreciated this distinction.

Given the Examiner's discussion with respect to claims 16-19, 22 and 27, the Examiner appears to have taken the position that Williams describes a system comprising a business interface, a customer interface, and a survey system and having the capability to conduct the tasks claimed. Accordingly, it would appear that the Examiner presented a *prima facie* case of anticipation for claims 15-19, 22 and 27 over Williams. It was then

incumbent on the Appellants to rebut the Examiner's rationale for rejecting the claims. We do not see in the Briefs that the Appellants have done so. Accordingly, we will sustain the rejection of these claims.

The rejection of claims 10, 12, 20, and 21 under § 103(a) as being unpatentable over Williams and Official Notice.

Claims 10 and 12

The Examiner did not additionally explain why one of ordinary skill in the art would be led to the subject matter of claim 1 given Williams. It appears the Examiner has relied upon the position that Williams describes the subject matter of claim 1 but further renders obvious the subject matter of these claims. However, we have found that Williams does not expressly or inherently describe the subject matter of claim 1. Accordingly, we will reverse the rejection as to these claims, which depend on claim 1, for the reasons we used above in reversing the rejection of claim 1, and find that the Examiner did not meet the initial burden of establishing a prima facie case of obviousness for the claimed subject matter.

Claims 20 and 21

We will sustain the rejection as to these claims.

The Appellants' response to the rejection of these claims is that the "Examiner has yet to cite any documentation to support the taking of Official Notice in this rejection" (App. Br. 10) and, after the Examiner cited Hawkins (US 5,497,317), Gerace (US 5,848,396), and Snelling (US 5,826,257) (see Answer 6), that "the Official Notice supported by the Hawkins, Gerace, and Snelling patents do not include any additional

disclosure combinable with the Williams patent to be material to patentability of these claims” (Reply Br. 10).

We are not persuaded by these arguments that the Examiner erred in the rejection of claims 20 and 21 under § 103 over Williams and Official Notice as evidenced by Hawkins, Gerace, and Snelling. The Appellants’ arguments do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Moreover, the Examiner has provided evidence to corroborate that view. Even if one were to interpret the Appellants’ arguments and comments as constituting a traverse, the Appellants’ arguments and comments do not appear to constitute an adequate traverse because the Appellants have not specifically pointed out the supposed errors in the Examiner’s position, which would include stating why the noticed facts are not considered to be common knowledge or well-known in the art as evidenced by Hawkins, Gerace, and Snelling. 27 CFR § 1.104(d)(2), MPEP § 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner’s notice of what is well known to one of ordinary skill in the art. *In re Boon*, 439 F.2d 724, 728 (CCPA 1971). That has not been done here. Accordingly, we sustain the rejection as to claims 20 and 21.

The rejection of claims 23-25 under § 103(a) as being unpatentable over Jones, III and Marsh.

The Appellants argued claims 23-25 as a group (App. Br. 11-14; Reply Br. 11-14). We select claim 23 as the representative claim for this

group, and the remaining claims 24 and 25 stand or fall with claim 23.
37 C.F.R. § 41.37(c)(1)(vii) (2007). We will sustain the rejection as to these claims.

As with apparatus claims 15-19, 22 and 27, claims 23-25 are worded so as to define the elements of the apparatus in terms of their capabilities. Claim 23 calls for a system comprising a business interface, a customer interface and a survey system and each of these elements are defined to be “operable” to perform certain tasks.

We are satisfied that the Examiner has presented a prima facie case of obviousness. The Examiner pointed to where in Jones III the claimed elements, including the capabilities defined by claim 23, are disclosed. (Answer 6). The Examiner argued that “Jones failed to explicitly teach demographic data being received directly from the consumer” (Answer 7) but relied on Marsh as teaching “the advertisement distribution scheduler used to target advertisements to particular users based on demographic information stored in a database management system” (Answer 7) to reach the conclusion that “it would have been obvious to one of ordinary skill in the art at the time of the invention to receive the customer data directly from the consumer (through survey). One would be motivated to include a survey in Jones targeted marketing for the intended purpose of collecting user’s demographic data, such as user interests, preferences, etc, as taught in Marsh.” (Answer 7). Therefore, the Examiner articulated an apparent reason to combine the reference teachings, with a logical underpinning, that would lead one of ordinary skill in the art to the claimed subject matter and thereby met the initial burden of establishing a prima face case of obviousness. The

burden thus shifted to the Appellants to show error in the Examiner's analysis.

First, the Appellants argued that "there is no suggestion or motivation in the Jones III, et al. patent or the Marsh, et al. patent to combine them as proposed by the Examiner." (App. Br. 11). Second, the Appellants argued that "a reasonable expectation of success has not been shown by the Examiner." (App. Br. 12). And third, the Appellants argued that "the Examiner has not shown that the proposed Jones III et al. – Marsh, et al. combination teaches and suggests all of the claim limitations." (App. Br. 13). The Appellants conclude that "the Examiner has failed to establish any of the criteria for a prima facie case of obviousness." (App. Br. 14). Similar arguments are made in the Reply Brief (see pages 11-14).

We will address the third argument first.

The argument that the Examiner has not shown all of the claimed limitations in the prior art is a challenge to the Examiner's understanding of the scope and content of the cited references, i.e., a challenge to the first factual inquiry in determining whether a claimed invention would have been obvious over cited prior art to one of ordinary skill in the art. But, in that regard, the Examiner clearly determined that Jones, III disclosed a system that met the basic elements of the claimed system (i.e., a business interface, a customer interface and a survey system). (See Answer 6). We do not see that the Appellants have disputed this. Accordingly, the only question is whether Jones III and Marsh further disclose that these elements are "operable" to perform the tasks claimed. That question the Appellants do not address.

The Appellants argue instead that the cited references do not show certain tasks being performed. For example, the Appellants argue that “the Jones III, et al. patent receives data from content providers accumulated based on past performance of consumers. Thus, the Jones III, et al. patent fails to receive data directly from customers as required in the claimed invention.” (App. Br. 13). However, claim 23 does not require a step of receiving data directly from customers. Claim 23 requires “a survey system operable to supply the business data processing system with targeted marketing reports, the targeted marketing reports dynamically generated based on a set of decision rules, the set of decision rules dynamically generated based on data received directly from the consumers.” Accordingly, claim 23 requires a survey system having the capability to supply targeted marketing reports of the type claimed to the business data processing system. While claim 23 requires that the targeted marketing reports being supplied to the survey system be of the type that are dynamically generated based on a set of decision rules and where the decision rules are in turn dynamically generated based on data received directly from the consumers, claim 23 does not require that any data be actually directly received from customers. The Examiner clearly stated that “Jones teaches ... a survey system operable to supply the business data processing system with a targeted marketing reports, the targeted marketing reports dynamically generated based on a set of decision rules, the set of decision rules (see col. 13 line 19 to col. 14 line 8) dynamically generated based on data received directly from the customer (see fig. 7-11, fig. 14, col. 6 line 38 to col. 17 line 45, col. 9 line 7-58).” (Answer 6). And the Examiner clearly stated that Marsh discloses directly receiving data from

consumers. (Answer 7). We do not see that the Appellants have challenged the Examiner's understanding of the scope and content of Jones, III, and Marsh. We note that the Appellants did argue that Marsh fails to disclose, for instance, "the use of decision rules to generate the targeted marketing reports." (App. Br. 13). But it is Jones, III, not Marsh, that the Examiner relied upon to show a survey system operable to supply the business data processing system with a targeted marketing reports, the targeted marketing reports dynamically generated based on a set of decision rules. (See Answer 6). For the foregoing reasons, we are not persuaded that the Appellants have shown error in the Examiner's understanding of the scope and content of the cited references.

As to the first argument that the Examiner has not shown a motivation to combine the disclosures in the cited references that would lead one of ordinary skill in the art to arrive at the claimed invention, this is not the standard for determining obviousness.

The Supreme Court decision in *KSR* has clarified the test for obviousness. In *KSR*, the Supreme Court emphasized "the need for caution in granting a patent based on the combination of elements found in the prior art," *id.* at 1739, and discussed circumstances in which a patent might be determined to be obvious without an explicit application of the teaching, suggestion, motivation test. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *Id.* (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.*

The operative question in this “functional approach” is “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740. Here the Examiner explained that each of the elements of the claimed apparatus was shown in the cited references and provided some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness for combining the elements in the manner claimed. “[W]hen a patent ‘simply arranges old elements with each performing the same function it had been known to perform’ and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at 1740, (quoting *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 282, 96 S.Ct. 1532 (1976)). It was not necessary, as the Appellants appear to argue, that the Examiner show a suggestion to combine the teachings of the references in the references themselves before coming to the conclusion that the claimed method would have been obvious to one of ordinary skill in the art.

As to the second argument that the Examiner has not shown a reasonable expectation of success, this too is not the standard for determining obviousness. In light of *KSR*, the question of whether there is a reasonable expectation of success is less an issue where, as here, the conclusion of obviousness was reached by the Examiner using the rationale that the claimed combination is no more than the predictable result of combining the Jones, III, survey system operable to supply the business data processing system with a targeted marketing reports, the targeted marketing reports dynamically generated based on a set of decision rules, the set of decision rules dynamically generated based on data received from the customer with Marsh’s disclosure of directly receiving data from consumers.

The question of a reasonable expectation of success plays a greater role in situations where the rationale employs more of an “obvious to try” reasoning – a reasoning which the Examiner did not use and which the Examiner did not need to be rely upon to make the prima facie case of obviousness.

The rejection of claims 23-25 under § 103(a) as being unpatentable over Jones, III and Marsh is affirmed.

The rejection of claim 28 under §103(a) as being unpatentable over Williams and Jones, III.

We affirm the Examiner’s rejection of claim 28 under § 103 over Jones, III and Marsh for the reasons stated above in support of the affirmance of claim 15 on which claim 28 depends and because the Appellants have not shown any additional error on the part of the Examiner in making the instant rejection.

The Appellants argue that “[c]laim 15, from which [c]laim 28 depends, has been shown above to be patentably distinct from Williams, et al. patent.” (App. Br. 15 and Reply Br. 15). We disagree and refer the Appellants to our discussion above regarding the rejection of claim 15. The Appellants also argue that “the Jones III, et al. patent does not include any additional disclosure combinable with the Williams, et al. patent that would be material to patentability of these claims.” (App. Br. 15 and Reply Br. 15). This is an argument challenging the rejection of claim 28 but which simply states, in whole or in part, that the references do not disclose or suggest certain claimed features without responding to the Examiner’s reasoning in establishing a prima facie case of obviousness. “It is not the function of this court to examine the claims in greater detail than argued by an appellant,

looking for nonobvious distinctions over the prior art.” *In re Baxter Travenol Labs*, 952 F.2d 388, 391 (Fed. Cir. 1991). See also *In re Wiseman*, 596 F.2d 1019, 1022 (CCPA 1979) (arguments must first be presented to the board). A general allegation that the art does not teach any of the claim limitations is no more than merely pointing out the claim limitations. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. 37 C.F.R. § 41.37(c)(1)(vii).

CONCLUSIONS OF LAW

We conclude that:

- the Appellants have shown that the Examiner erred in rejecting claims 1-9, 11-14, and 26 under 35 U.S.C. § 102(e) as being anticipated by Williams and in rejecting claims 10 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Williams and Official Notice; and
- the Appellants have *not* shown that the Examiner erred in rejecting claims 15-19, 22, and 27 under 35 U.S.C. § 102(e) as being anticipated by Williams; in rejecting claims 20 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Williams and Official Notice; in rejecting claims 23-25 under 35 U.S.C. § 103(a) as being unpatentable over Jones, III and Marsh; and in rejecting claim 28 under 35 U.S.C. § 103(a) as being unpatentable over Williams and Jones, III.

DECISION

The decision of the Examiner to reject claims 1-28 is affirmed-in-part.

AFFIRMED-IN-PART

Appeal 2008-2338
Application 09/966,845

JRG

BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS, TX 75201-2980